REMARKS/ARGUMENTS

The applicant requests reconsideration of the present application in view of the above changes to the claims and the following remarks, which are responsive to the Office Action mailed September 20, 2005.

I. Status of Claims

In the Office Action, Claims 1-20 were noted as pending in the application and were rejected. As a result of this response, Claims 1-20 remain pending in the application, and Independent Claims 1, 12 and 20 and dependent Claim 2 are currently amended in order to further clarify the claimed invention.

II. Claim Rejections

a. 35 U.S.C. §101

The Examiner rejected Claims 1-20 under 35 U.S.C. §101 stating that the invention as claimed is directed to non-statutory subject matter. (Office Action, pg. 2, para. 4). The Examiner concedes that the recited process produces a useful, concrete, and tangible result, but states that the invention as a whole is not within the technological arts. (*Id.* at pg. 5, para. 9).

In response, the Applicant points to the recent Board of Patent Appeals and Interferences (hereinafter "the Board") decision in *Ex Parte Carl A. Lundgren* (Appeal No. 2003-2088), which held that "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under §101." (*Lundgren*, pg. 9). In rendering this decision, the Board referenced the Court of Appeals for the Federal Circuit's decision in *AT&T Corp. v. Excel Communications, Inc.*, which held that a process claim that applies a mathematical algorithm to "produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face comfortably falls within the scope of §101." (172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999).

Applicant further points to the United States Patent and Trademark Office Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (OG Notice: 22 November 2005), which state:

> For claims including [abstract ideas, natural phenomena, and laws of nature] to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon ... which may be identified in various ways:
>
> - The claimed invention "transforms" an article or physical object to a different state or thing.
>
> - The claimed invention otherwise produces a useful, concrete and tangible result[.]

(Guidelines, Part IV. C. 2.).

As stated above, the Examiner concedes that the recited process produces a useful, concrete, and tangible result (Office Action, pg. 5, para. 9). In light of the foregoing, Applicant respectfully requests that the rejection of Claims 1-20 under 35 U.S.C. §101 be withdrawn.

b. 35 U.S.C. §102

The Examiner rejected Claims 1-20 under 35 U.S.C. §102(e) as being anticipated by Daniel Williams et al. (U.S. Pub. No. 2002/0032612 A1) (hereinafter "*Williams et al.*"). (Office Action, pg. 6, para. 10). For at least the reasons set forth below, Applicant submits that the claims as amended are not anticipated by *Williams et al.*, and respectfully requests that the rejection be withdrawn.

In particular, reference is made to Independent Claim 1, which is reproduced below, as amended, for the Examiner's convenience.

> 1. (Currently Amended) A method for a merchant to provide an electronic return shipping label to a customer to allow said customer to return goods, comprising the steps of:
> receiving a return request for said goods from said customer;
> obtaining shipping information related to said return request; ~~and~~
> **transmitting said shipping information to a carrier server, said carrier server capable of processing said shipping information and generating said electronic return shipping label based at least in part on said shipping information;**
> **receiving said electronic return shipping label from said carrier server; and**
> electronically providing said customer with said return shipping label that can be printed and affixed to a package for returning said goods.

Applicant respectfully asserts that *Williams et al.* does not teach or suggest "transmitting said shipping information to a ***carrier server***, said carrier server capable of processing said shipping information and generating said electronic return shipping label based at least in part on said shipping information." (Applicant's Claim 1).

Williams et al. discloses a Return System that "provides multi-carrier shipment rating, shipment labeling, shipment tracking, shipment tracking management reports, returns analysis and returns management reporting." (*Williams et al.*, Abstract). In particular, the Return System of *Williams et al.* "provides a plurality of online eCommerce Merchants with a single User Interface ('UI') with which each eCommerce Merchant can provide the Merchant's consumer with an automated return parcel management system for a plurality of supported carriers." (*Id.* at para. 127).

According to *Williams et al.*, "the *Return System* prepares a shipping label for the item package." (*Id.* at para. 258, *emphasis added*).

> The Return Merchant Service System (sometimes referred to herein as the "iReturn" system) component of [*Williams et al.*] provides a merchandise return computer system that is programmed to, among other things ... generate as a response to a second computer system a shipping label for shipping a particular package in response to a request received from the second computer system to prepare a shipping label for shipping a particular package by one of a plurality of

> carriers and send the shipping label response to the second computer system. (*Id.* at para. 412).
>
> As depicted in **FIG. 27*b***, one of the System Servers, for instance, a Shipping Server, e.g., **21*s*** (**FIG. 3*a***), gets the Label Size from the Carrier Label Specification **1250**, the Label Layout from the Carrier Label Specification **1251**, Label Data from the Shipper Database **1252**, and the Label Quality in Dots Per Inch ("DPI") as set by the Server **1253**, and uses this information to Generate a Label **1254**. (*Id.* at para. 271).
>
> iReturn Merchant Service Application Interfaces (APIs), **4020** through **4023**, are provided on one or more API servers ... The iReturn Merchant Service System **4000** provides, for example, four APIs ... The Label Package API **4023** processes requests to print shipping labels and in response to such requests, accesses a Location Database **4026** and the iReturn Database **4028** to obtain information with which to print shipping labels ... (*Id.* at paras. 448 and 450).
>
> Based upon the Label Type in the relevant API Request, the iReturn System will prepare the following relevant type of label for the specified carrier and service ... (*Id.* at para. 772).

The Return System of *Williams et al.* is distinct from the plurality of carriers to which the Return System provides customers access. ("The online Merchant's store 2*a* provides the Consumer 3*a* with access to the Return System 1 through which the Consumer interfaces with supported Carriers 4*a* through 4*n*" (*Id.* at para. 136); and "The System **4000** communicates through the Internet **4003**' with a plurality of Carrier systems, e.g., **4010-1** through **4010-*n*** to track shipment and delivery status of shipped parcels" (*Id.* para. 417).)

As shown, according to *Williams et al.*, the iReturn/Return System, and not a carrier server, generates the shipping label. *Williams et al.* does not, therefore, teach or suggest "transmitting said shipping information to a *carrier server*, said carrier server capable of processing said shipping information and generating said electronic return shipping label based at least in part on said shipping information." (Applicant's Claim 1). Independent Claim 1 is, therefore, not anticipated by *Williams et al.*

Based on the foregoing, Applicant respectfully requests that the rejection of Independent Claim 1 under 35 U.S.C. §102(e) be withdrawn.

Claims 2-11 depend from Independent Claim 1 and include all of the limitations of that Claim. Thus, for at least the reasons set forth above with respect to amended Independent Claim 1, it is submitted that dependent Claims 2-11 are further not anticipated by *Williams et al.* Applicant respectfully requests, therefore, that the rejection of dependent Claims 2-11 under 35 U.S.C. §102(e) be withdrawn.

Reference is now made to Independent Claim 12, which is reproduced below, as amended, for the Examiner's convenience.

> 12. (Currently Amended) A method for a merchant to provide an electronic return shipping label to a customer to allow said customer to return goods, comprising the steps of:
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> receiving a return request for said goods from said customer;
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> obtaining shipping information related to said return request;
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> transmitting said shipping information to ~~an application service provider~~ a carrier server, said ~~application service provider~~ carrier server configured to process said shipping information and generate said return shipping label; and
>
> generating said return shipping label at said ~~application service provider~~ carrier server, wherein said carrier server is further configured to provide ~~; and~~
>
> ~~providing~~ said customer electronic access to said return shipping label.

Applicant respectfully asserts that *Williams et al.* does not teach or suggest "transmitting said shipping information to a carrier server, said carrier server configured to process said shipping information and generate said return shipping label; [or] generating said return shipping label at said carrier server, wherein said carrier server is further configured to provide said customer electronic access to said return shipping label." (Applicant's Claim 12).

As stated above, according to *Williams et al.*, the Return System, which is distinct from the plurality of carrier systems with which the Return System interfaces, generates the return shipping label. Applicant respectfully submits, therefore, that *Williams et al.* does not anticipate Independent Claim 12.

Based on the foregoing, Applicant respectfully requests that the rejection of Independent Claim 12 under 35 U.S.C. §102(e) be withdrawn.

Claims 13-19 depend from Independent Claim 12 and include all of the limitations of that Claim. Thus, for at least the reasons set forth above with respect to amended Independent Claim 12, it is submitted that dependent Claims 13-19 are further not anticipated by *Williams et al.* Applicant respectfully requests, therefore, that the rejection of dependent Claims 13-19 under 35 U.S.C. §102(e) be withdrawn.

Reference is now made to Independent Claim 20, which is reproduced below, as amended, for the Examiner's convenience.

> 20. (Currently Amended) A system for a merchant to electronically provide a return shipping label to a customer that wishes to return goods, comprising:
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> a merchant server, hosting a merchant website and capable of communicating with ~~an application service provider~~ a carrier server and at least one customer computer;
>
> ~~an application service provider~~ a carrier server in communication with said merchant server;
>
> an application service provider application, residing on said ~~application service provider~~ carrier server configured to generate said return shipping label based at least on part on shipping information received from said merchant server; and
>
> a customer computer for receiving said return shipping label.

For reasons similar to those discussed above with respect to Independent Claims 1 and 12, Applicant respectfully asserts that *Williams et al.* does not teach or suggest "an application service provider application, residing on said carrier server configured to generate said return shipping label based at least in part on shipping information received from said merchant server." (Applicant's Claim 20). *Williams et al.*, therefore, does not anticipate Independent Claim 20.

Based on the foregoing, Applicant respectfully requests that the rejection of Claim 20 under 35 U.S.C. §102(e) be withdrawn.

III. Conclusion

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (571) 273-8300 on the date shown below.

Laisha Richardson 12/13/05

Laisha Richardson Date